

## **Allowable Subject Matter**

Claims 1-4 were deemed allowable over the prior art of record. Applicants appreciate the Examiner's indication of those claims being allowable.

## **Claim Rejections**

Claims 5-39 were rejected under 35 U.S.C. § 251. The Office Action alleges that claims 5-39 improperly claim subject matter that was deliberately surrendered in the application for the patent upon which the present reissue is based. Accordingly, the Office Action rejected claims 5-39 as being claims which improperly recaptured subject matter that was originally presented, argued, or stated in the original application so as to make those claims allowable over a rejection or objection. Applicants respectfully disagree.

In accordance with MPEP 1412.02, a recapture assertion can only be sustained if, indeed, subject matter was recaptured in a reissue application. According to the Federal Circuit, a two-step test must be applied to determine if recapture has occurred. *In Re Clement*, 131 F.3d. 1464, 45 USPQ 2d. 1161 (Fed. Cir. 1997). First, one must determine whether the reissue claims are broader than the original patent claims. Second, one must determine whether the broader reissue claims relate to surrendered subject matter -- i.e., subject matter that was surrendered during prosecution of the original patent. *See Mentor Corp. v. Coloplast, Inc.*, 998 F.2d. 992, 27 USPQ 2d. 1521 (Fed. Cir. 1993). The surrendered subject matter can arise either through changes to the claims made in an effort to overcome a prior art rejection, or simply arguments lodged during prosecution of the original patent application to distinguish over prior art. *Ball Corp. v. United States*, 729 F.2d. 1429, 221 USPQ 289 (Fed. Cir. 1984).

In the inventors' declaration filed with the reissue application, the inventors stated they had claimed less than they had a right to claim and, therefore, the reissue application is needed to correct errors made by the inventors. For example, the declaration states that claim 4 of the original patent recites a "recording means." The inventors believe that a recording means need not be claimed. Instead, an instructional apparatus not having a recording means would, indeed, provide broader claim coverage.

Using the “recording means” example, Applicants would assert that the present independent claims 5, 12, 18, 24, 29, and 35, as well as claims dependent therefrom, not having a recording means would be broader than claim 4 of the original patent. Thus, the first step for determining recapture has been met -- the reissue claims are broader in some respects than the patent claims. Next, a determination must be made on whether the original patent contains arguments or changes to the claims, where “recording means” was added in an effort to overcome a prior art rejection. Absent the addition of the subject matter (or argument made as to the import of the subject matter) now deleted in order to effectuate allowance in the original patent, a recapture assertion cannot be sustained.

Upon review of the file history of the original patent, including the Appeal Brief and the decision by the Board of Patent Appeals and Interferences, no mention whatsoever was made about the recording means as being an element needed to gain issuance of the original patent. Not only was the “recording means” a part of the original claim and, thus, was not added to obtain allowance over the prior art, but also the recording means was never argued as having a positive impact on allowance. Simply put, the inclusion (or absence of) a recording means was never an issue whatsoever in the allowance of the original patent.

The Office Action alleges that, in addition to recapture by the omission of “recording means”, reciting a “bar coded label” also constitutes recapture. Applicants respectfully disagree. The bar coded label referenced in the Office Action and recited in the various independent claims presented in the reissue application is also an element in original claim 4. Certainly, the use of a bar code label of the present claims, which is also a part of the original and issued claims of the original patent, should not constitute recapture. Bar code label was not deleted from the original claims, such that addition now of that feature would constitute an impermissible recapture. Moreover, like “recording means,” “bar code label” had no impact whatsoever in the prosecution or appeal of the original patent claims.

Applicants invite the Examiner to provide some support for the assertion that “recording means” and/or “bar code label” had an impact in the prosecution of the original patent claims, such that the use (or lack of use) of such terms in the present claims would constitute recapture. Certainly, certain features like the label being releasably secured to a product, or that a vocal message can be repetitively and reusable recorded were important to the originally filed claims 1-18. However, with respect to the originally filed claims 19-24 which ensued into the issued claims, the only feature argued over the prior

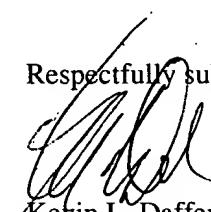
art was that the prior art discloses synthetic speech. *See* page 20 of Appellants' Brief and page 8 of the Board's Decision.

### CONCLUSION

This response constitutes a complete response to all issues raised in the Office Action mailed November 14, 2002. In view of the remarks traversing the rejections, Applicants assert that pending claims 1-39 are in condition for allowance. If the Examiner has any questions, comments or suggestions, the undersigned attorney earnestly requests a telephone conference.

No fees are required for filing this amendment; however, the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment, to Conley Rose, P.C. Deposit Account No. 03-2769/5007-00700.

Respectfully submitted,



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